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PATENT

Attorney Docket No.: 20518/62 (S-8492)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Barrus et al.

EXAMINER: Catherine Williams

SERIAL NO.: 10/016,276

GROUP: 3763

FILED: December 6, 2001

CONFIRMATION NO.: 4052

FOR: *Safety Shield for Medical Needles*

\*\*\*\*\*

CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450:

By: *Michelle A. Aiello* Date: *11-9-2004*  
Michelle A. Aiello

\*\*\*\*\*

PETITION TO CLAIM BENEFIT UNDER 35 U.S.C. 120

OF PRIOR FILED APPLICATIONS

(37 C.F.R. 1.78(a)(3))

MAIL STOP PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

1. Applicant hereby petitions, in accordance with § 1.78(a)(3) to claim the benefit for the above referenced application under 35 U.S.C. 120 of prior applications (as presented in an Amendment dated May 11, 2004 in the above referenced application, copy enclosed):

**BEST AVAILABLE COPY**

**CROSS-REFERENCE TO RELATED APPLICATIONS**

This patent application is a continuation-in-part of U.S. Utility Patent Application Serial No. 09/892,593, filed in the USPTO on June 27, 2001 by Ferguson et al., which is a continuation-in-part of U.S. Utility Patent Application Serial No. 09/433,449, filed November 4, 1999, U.S. Utility Patent Application Serial No. 09/434,036, filed November 4, 1999, and U.S. Utility Patent Application Serial No. 09/619,190, filed July 19, 2000, which claims benefit of U.S. Provisional Application Serial No. 60/254,506 filed in the USPTO on December 8, 2000 by Thorne et al., U.S. Provisional Application Serial No. 60/275,810, filed on March 14, 2001, U.S. Provisional Application Serial No. 60/275,886, filed March 14, 2001 and U.S. Provisional Application Serial No. 60/296,968 filed in the USPTO on June 8, 2001 by Barrus et al., the entire contents of each of these applications being hereby incorporated by reference herein.

2. Applicant states that the entire delay between the date the claim for the benefit of the earlier applications was due under paragraph (a)(2) of 37 C.F.R. § 1.78 and the date this claim is filed was unintentional.

3. The surcharge fee set forth in § 1.17(t), required by 37 C.F.R. 1.78(a)(3)(ii), is paid as follows:

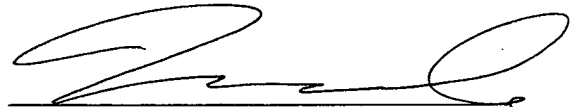
- ☐ Attached is a ☐ check ☐ money order in the amount of \$ 00
- ☒ Authorization is hereby made to charge the amount of \$1,370.00
- ☒ to Deposit Account No. 500369
- ☐ to Credit card as shown on the attached credit card information authorization form PTO-2038
- ☒ Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

Respectfully submitted,

Dated: Nov. 9, 2004

By:



Mark S. Leonardo, Reg. No. 41,433

Attorney for Applicants

Customer No. 21710

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USPTO TRANSMITTAL

Atty Initials: MSL/map  
Docket No.: 20518/62 (f/k/a 20518  
10/24.2)

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Inventor(s): Barrus et al.  
Appl No.: 10/016,276  
Filing Date: December 6, 2001

Mailing Date: May 11, 2004  
Client: Tyco Healthcare Group LP  
Patent No.  
Issue Date:

Title: Safety Shield for Medical Needles

Enclosed is:  
Certificate of Mailing dated May 11, 2004 via First Class Mail  
- Amendment Transmittal (1 pg)  
- Amendment (12 pages)

USPTO TRANSMITTAL

Atty Initials: MSL/map  
Docket No.: 20518/62 (f/k/a 20518/  
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Inventor(s): Barrus et al.  
Appl No.: 10/016,276  
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Client: Tyco Healthcare Group LP  
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Title: Safety Shield for Medical Needles

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## AMENDMENT TRANSMITTAL LETTER (Large Entity)

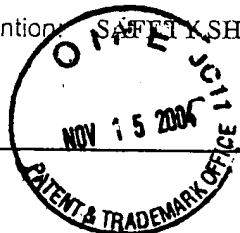
Applicant(s): Barrus et al.

Docket No.

20518/62 (f/k/a 20518/10/24.2)

Serial No.  
10/016,276Filing Date  
December 6, 2001Examiner  
Williams, Catherine SerkeGroup Art Unit  
3763

Invention: SAFETY SHIELD FOR MEDICAL NEEDLES

TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

## CLAIMS AS AMENDED

	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	21 -	40 =	0 x	\$18.00	\$0.00
INDEP. CLAIMS	3 -	4 =	0 x	\$86.00	\$0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					\$0.00

- ☒ No additional fee is required for amendment.
- ☐ Please charge Deposit Account No. \_\_\_\_\_ in the amount of \_\_\_\_\_
- ☐ A check in the amount of \_\_\_\_\_ to cover the filing fee is enclosed.
- ☒ The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 500369
- ☒ Any additional filing fees required under 37 C.F.R. 1.16.
- ☐ Any patent application processing fees under 37 CFR 1.17.

Signature

Dated: May 11, 2004

Mark S. Leonardo, Esq. (Reg. No. 41,433)  
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class mail under 37C.F.R. 1.8 and is addressed to the  
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Signature of Person Mailing Correspondence

Michelle A. Phinnèy

Typed or Printed Name of Person Mailing Correspondence

CC:



PATENT  
Docket No.: 20518/62 (S-8492)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Barrus et al. Group: 3763  
Application No.: 10/016,276 Confirmation No.: 4052  
Filed: December 6, 2001 Examiner: Williams, Catherine Serke  
For: SAFETY SHIELD FOR MEDICAL NEEDLES

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to, Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

May 11, 2004  
Date

By: Michelle A. Phinney  
Michelle A. Phinney

AMENDMENT

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Examiner:

In response to the Office Action dated February 12, 2004, please consider the following amendments and remarks set forth below. Applicant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee, for such extension is to be charged to Deposit Account No. 50-0369.

## IN THE SPECIFICATION

Please delete the first full paragraph corresponding to "Cross-Reference to the Related Applications," and replace the corresponding paragraph on page 1 of the specification:

## CROSS-REFERENCE TO RELATED APPLICATIONS

This patent application is a continuation-in-part of U.S. Utility Patent Application Serial No. 09/892,593, filed in the USPTO on June 27, 2001 by Ferguson et al., which is a continuation-in-part of U.S. Utility Patent Application Serial No. 09/433,449, filed November 4, 1999, U.S. Utility Patent Application Serial No. 09/434,036, filed November 4, 1999, and U.S. Utility Patent Application Serial No. 09/619,190, filed July 19, 2000, which claims benefit of U.S. Provisional Application Serial No. 60/254,506 filed in the USPTO on December 8, 2000 by Thorne et al., U.S. Provisional Application Serial No. 60/275,810, filed on March 14, 2001, U.S. Provisional Application Serial No. 60/275,886, filed March 14, 2001 and U.S. Provisional Application Serial No. 60/296,968 filed in the USPTO on June 8, 2001 by Barrus et al., the entire contents of each of these applications being hereby incorporated by reference herein.

## IN THE CLAIMS

Please amend Claims 1, 33 and 38 as follows:

1. (Amended) A safety shield apparatus comprising:

a needle having a distal portion and a proximal portion; and

a shield including at least one elongated part, the shield having a proximal end mounted with the proximal portion of the needle and a distal end mounted with a planar contact surface, the planar contact surface including a needle linear bearing that slidably facilitates movement of the needle relative to the shield, the shield being extensible between a retracted position and an extended position via fixed positioning of the planar contact surface relative to movement of the shield.

2. (Original) A safety shield apparatus according to claim 1, further comprising a needle hub configured to support the proximal portion of the needle.
3. (Original) A safety shield apparatus according to claim 2, wherein the needle hub includes an appendage.
4. (Original) A safety shield apparatus according to claim 3, wherein the appendage has at least one opening to facilitate manipulation thereof.
5. (Original) A safety shield apparatus according to claim 3, wherein the appendage has at least one wing for manipulation thereof.
6. (Original) A safety shield apparatus according to claim 1, wherein the shield includes at least one segment.
7. (Original) A safety shield apparatus according to claim 1, wherein the distal portion of the needle is angularly displaced approximately 90 degrees from the proximal portion.
8. (Original) A safety shield apparatus according to claim 1, wherein the planar contact surface includes a pad for engagement with a subject.
9. (Original) A safety shield apparatus according to claim 6, wherein the segment defines a channel.
10. (Withdrawn) A safety shield apparatus according to claim 6, wherein the segment defines a channel and the shield has a slider configured for slidable movement with the channel.



11. (Original) A safety shield apparatus according to claim 1, wherein the shield includes a latch engageable with the needle.

12. (Original) A safety shield apparatus according to claim 11, wherein the latch includes a latch arm for maintaining the shield in the extended position.

13. (Original) A safety shield apparatus according to claim 11, wherein the latch includes a plurality of surfaces configured to maintain the shield in the extended position.

14. (Original) A safety shield apparatus according to claim 11, wherein the latch includes an arcuate surface engageable with the needle.

15. (Withdrawn) A safety shield apparatus comprising:

a needle having a distal portion defining a longitudinal axis which is angularly displaced relative to a longitudinal axis defined by a proximal portion of the needle; and

a shield mounted with the needle and extensible, via a needle guide movably guiding the needle, between a retracted position and an extended position.

16. (Withdrawn) A safety shield apparatus according to claim 15, further comprising a needle hub configured to support the proximal portion of the needle.

17. (Withdrawn) A safety shield apparatus according to claim 16, wherein the needle hub includes an appendage.

18. (Withdrawn) A safety shield apparatus according to claim 17, wherein the appendage has at least one opening to facilitate manipulation thereof.

19. (Withdrawn) A safety shield apparatus according to claim 17, wherein the appendage has at least one wing for manipulation thereof.

20. (Withdrawn) A safety shield apparatus according to claim 15, wherein the shield includes at least one segment.

21. (Withdrawn) A safety shield apparatus according to claim 15, wherein the distal portion of the needle is angularly displaced approximately 90 degrees from the proximal portion.

22. (Withdrawn) A safety shield apparatus according to claim 15, wherein a distal end of the shield is attached to a planar contact surface.

23. (Withdrawn) A safety shield apparatus according to claim 22, wherein the planar contact surface includes a pad for engagement with a subject.

24. (Withdrawn) A safety shield apparatus according to claim 15, wherein a distal end of the shield is hingedly attached to a planar contact surface.

25. (Withdrawn) A safety shield apparatus according to claim 15, wherein a distal end of the shield is releasably attached to a planar contact surface.

26. (Withdrawn) A safety shield apparatus according to claim 24, wherein the planar contact surface includes a pad for engagement with a subject.

27. (Withdrawn) A safety shield apparatus according to claim 20, wherein the segment defines a channel.

28. (Withdrawn) A safety shield apparatus according to claim 20, wherein the segment defines a channel and the shield has a slider configured for slidable movement with the channel.

29. (Withdrawn) A safety shield apparatus according to claim 15, wherein the shield includes a latch engageable with the needle.

30. (Withdrawn) A safety shield apparatus according to claim 29, wherein the latch includes a latch arm for maintaining the shield in the extended position.

31. (Withdrawn) A safety shield apparatus according to claim 29, wherein the latch includes a plurality of surfaces configured to maintain the shield in the extended position.

32. (Withdrawn) A safety shield apparatus according to claim 29, wherein the latch includes an arcuate surface engageable with the needle.

33. (Amended) A safety shield apparatus comprising:

a needle having a distal portion defining a longitudinal axis which is angularly displaced relative to a longitudinal axis defined by a proximal portion of the needle; and

a shield including at least one elongated part, the shield having a proximal end mounted with the proximal portion of the needle and a distal end mounted with a planar contact surface, the planar contact surface including a needle linear bearing that slidably facilitates movement of the needle relative to the shield, the shield being extensible between a retracted position and an extended position via fixed positioning of the planar contact surface relative to movement of the shield.

34. (Original) A safety shield apparatus according to claim 33, wherein the planar contact surface includes a plurality of openings.

35. (Original) A safety shield apparatus according to claim 33, wherein the planar contact surface includes an anchor part.

36. (Original) A safety shield apparatus according to claim 33, wherein the distal end of the shield is hingedly attached to the planar contact surface.

37. (Original) A safety shield apparatus according to claim 33, wherein the planar contact surface includes a pad for engagement with a subject.

38. (Amended) A safety shield apparatus comprising:

a needle having a distal portion defining a longitudinal axis which is angularly displaced relative to a longitudinal axis defined by a proximal portion of the needle; and

a shield means, mounted with the needle and extensible between a retracted position and an extended position, for preventing hazardous exposure to the distal portion of the needle, the shield means having a planar body contacting surface, the planar body contacting surface including a needle linear bearing that slidably facilitates movement of the needle relative to the shield via fixed positioning of the planar contact surface relative to movement of the shield.

39. (Original) A safety shield apparatus according to claim 38, further comprising a latch means engageable with the needle for maintaining the shield means in the extended position.

40. (Previously Presented) A safety shield apparatus according to claim 1,  
wherein the planar contact surface includes texturing.

### REMARKS

This application has been reviewed in light of the Office Action dated February 12, 2004. Claims 1-40 are pending in the application. Claims 10 and 15-32 are withdrawn. Claims 1, 33 and 38 are amended in a manner that Applicants believe overcome the rejections in the Office Action. Support for the amendments can be found throughout the specification and figures of the present disclosure and recite aspects of the disclosure that Applicants are believed to be entitled. Applicants submit that no new matter or issues are introduced by the amendments.

Initially, the Examiner requests amendment of the specification to include specific reference to earlier filed applications. The present application is amended to reflect continuation and priority claims to these earlier filed applications to receive the corresponding priority benefit.

In the Office Action, claims 1-6, 9 and 10-14 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,823,997 to Thorne (Thorne '997). However, it is respectfully submitted that amended independent claim 1, claims 2-6 and 9-14 depending therefrom (although claim 10 is withdrawn from consideration), clearly and patentably distinguish over the Thorne '997 patent.

Referring to FIGURES 9 and 10, the Thorne '997 patent discloses a shroud 140 having a distal part 170. (col. 7, lines 39-47). Part 170 is rotated such that a superior face 206, located at the free distal end of part 170, is distally disposed relative to a needle tip 44. (col. 8, lines 8-10 and 20-23). In contrast, amended claim 1 of the present application recites "[a] safety shield apparatus comprising: a needle having a distal portion and a proximal portion; and a shield including at least one elongated part, the shield having a proximal end mounted with the proximal portion of the needle and a distal end mounted with a planar contact surface, the planar contact surface including a needle linear bearing that slidably facilitates movement of the needle relative to the shield; the shield being extensible between a retracted position and an extended position via fixed positioning of the planar contact surface relative to movement of the shield."

The Thorne '997 patent in no way discloses or suggests structure as recited in amended claim 1. The Thorne '997 patent does not disclose, *inter alia*, a safety shield having a distal end mounted with a planar contact surface, the planar contact surface including a needle linear

bearing that slidably facilitates movement of the needle relative to the shield, the shield being extensible between a retracted position and an extended position via fixed positioning of the planar contact surface relative to movement of the shield. Rather, the Thorne '997 patent shows a free distal face that does not facilitate slidable movement of the needle. One of the advantages of Applicant's claimed configuration is the prevention of undesired rebound or jerking motion during extension of the shield.

Because of the above distinctions, it is respectfully submitted that amended independent claim 1, claims 2-6 and 9-14 depending therefrom are patentable and not obvious over the Thorne '997 patent. Reconsideration and withdrawal of the rejection is respectfully requested.

In the Office Action, claims 1-3, 5-9, 11-14 and 33-40 were rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 5,997,504 to Bell (Bell '504). However, it is respectfully submitted that amended independent claim 1, claims 2, 3, 5-9, 11-14 depending therefrom, amended independent claim 33, claims 34-37 depending therefrom, amended independent claim 38 and claims 39-40 depending therefrom, clearly and patentably distinguish over the Bell '504 patent.

Referring to FIGS. 4A, 11 and 12A-12C, the Bell '504 patent discloses an assembly base 120, coupled to a needle assembly 104, such that a needle 16 extends through an open space defined by an aperture rim 131. (col. 12, lines 34-40). An exterior housing 28 facilitates sliding motion of needle assembly 104 via lateral slots 42. (col. 12, lines 27-32). In contrast, amended claim 1 of the present application is recited above. Amended claim 33 of the present application recites, *inter alia*, "[a] safety shield comprising...a shield including... a distal end mounted with a planar contact surface, the planar contact surface including a needle linear bearing that slidably facilitates movement of the needle relative to the shield, the shield being extensible between a retracted position and an extended position via fixed positioning of the planar contact surface relative to movement of the shield." Amended claim 38 recites, *inter alia*, "[a] safety shield comprising... a shield means... having a planar body contacting surface, the planar body contacting surface including a needle linear bearing that slidably facilitates movement of the needle relative to the shield via fixed positioning of the planar contact surface relative to movement of the shield."

The Bell '504 patent in no way discloses or suggests structure as recited in amended claims 1, 33 and 38. The Bell '504 patent does not disclose, *inter alia*, a safety shield having a distal end mounted with a planar contact surface, the planar contact surface including a needle linear bearing that slidably facilitates movement of the needle relative to the shield, the shield being extensible between a retracted position and an extended position via fixed positioning of the planar contact surface relative to movement of the shield. Rather, the Bell '504 patent shows a base rim that defines an open space adjacent to the needle; the base rim does not facilitate slidable movement of the needle.

Because of the above distinctions, it is respectfully submitted that amended independent claim 1, claims 2, 3, 5-9, 11-14 depending therefrom, amended independent claim 33, claims 34-37 depending therefrom, amended independent claim 38 and claims 39-40 depending therefrom are patentable and not obvious over the Bell '504 patent. Reconsideration and withdrawal of the rejections are respectfully requested.

In view of the foregoing amendments and remarks, it is respectfully submitted that claims 1-40 presently pending in the application are believed to be in condition for allowance and patentably distinguish over the art of record. An early notice thereof is earnestly solicited.

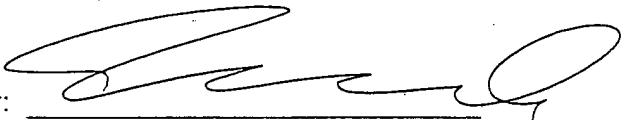
If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call the Applicants' undersigned attorney.



Please charge any deficiency as well as any other fee(s) which may become due at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 50-0369. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 50-0369 therefor.

Respectfully submitted,

Dated: MAY 11, 2004

By: 

Mark S. Leonardo  
Reg. No. 41,433  
Customer No. 21710  
Attorney for Applicants  
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